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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,277	09/25/2001	Ralf M. Luche	200125,434	9940
500	7590	11/19/2004	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			YU, MISOOK	
701 FIFTH AVE			ART UNIT	
SUITE 6300			PAPER NUMBER	
SEATTLE, WA 98104-7092			1642	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/964,277

**Applicant(s)**

LUCHE ET AL.

**Examiner**

MISOOK YU, Ph.D.

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 51, 55-58 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51 and 56 is/are allowed.
- 6) ☐ Claim(s) 55, 57, 58, 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicant's amendment filed on 09/10/2004 is acknowledged. Claims 51, 55, 56, 57, and 63 are amended. Claims 51, 55-58, and 63 are pending and under consideration.

This Office action contains new grounds of rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Specification, Withdrawn***

The objection of the specification due to an embedded hyperlink and/or other form of browser-executable code is withdrawn in view of the amendment to the specification.

#### ***Claim Objections, Withdrawn***

The objection of claims is withdrawn in view of the amendment.

#### ***Claim Rejections - 35 USC § 112, Withdrawn***

The rejection of the claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is **withdrawn** in view of the amendment.

The rejection of claims under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:20 encoding for the full-length protein SEQ ID NO21, does not reasonably provide enablement for any polynucleotide encoding a fragment of said protein or a mutant of said protein is **withdrawn** in view of the amendment.

***Claim Rejections - 35 USC § 102, Withdrawn***

The rejection of the claims under 35 U.S.C. 102(e) as being anticipated by US Pat.6,664,089 (effective filing date Mar. 24, 2000) is **withdrawn** because the amended claims are no longer anticipated by the art.

***The Following is New Ground of Rejection***

***Claim Rejections - 35 USC § 112***

Claims 55, 57, 58, and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The newly amended claims 55, and 63 are drawn to an isolated nucleic acid, and method of using said nucleic acid that meets three criteria, i.e. (1) at least 90% identical to SEQ ID NO:20; (2) encodes a polypeptide capable of dephosphorylating an activated MAP kinase; and (3) the encoded polypeptide comprises SEQ ID NO:16. Applicant states that the support for the amended claims is found at pages 12, 13, 14, and 16. The scope of the genus of the claimed nucleic acids in instant claims 55, and 63 are different than the scope found at pages 12, 13, 14, and 16 of the specification as originally filed. The specification as originally filed does not have support for the genus of the nucleic acids that meet the three criteria. It is noted that the specification as originally filed has support for "90% identical", dephosphorylating MAP-kinas, or SEQ ID NO:1. However, the specification as originally filed does not reasonably communicate

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that the applicant's invention is genus of nucleic acid molecules at least 90% identical to SEQ ID NO:20, encode a polypeptide capable of dephosphorylating an activated MAP kinase; **and** the encoded polypeptide comprises SEQ ID NO:16.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MISOOK YU, Ph.D.  
Examiner  
Art Unit 1642



WILLIAM R. HELMS, PH.D.  
PRIMARY EXAMINER